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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,005	09/21/2000	Tomotoshi Sato	49986-0500	8312
29989	7590	03/22/2006	EXAMINER	
HICKMAN PALERMO TRUONG & BECKER, LLP 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110				ART UNIT
				PAPER NUMBER

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Notification of Non-Compliant Appeal Brief (37 CFR 41.37)</b>	<b>Application No.</b> 09/668,005	<b>Applicant(s)</b> SATO, TOMOTOSHI
	<b>Examiner</b> Doug Hutton	<b>Art Unit</b> 2176

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 15 August 2005 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1.  The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2.  The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3.  At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4.  (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5.  The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi))
6.  The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7.  The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8.  The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9.  The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10.  Other (including any explanation in support of the above items):

see Attachment "A," authored by Craig Feinberg (571-272-9797), for an explanation of the defective aspects of the Appeal Brief.



Doug Hutton  
Primary Examiner  
Art Unit: 2176



# Attachment "A"

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte TOMOTOSHI SATO

Application No. 09/668,005

MAILED

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PAT & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

## ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on January 24, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

A review of the filed indicates that the Appeal Brief filed August 15, 2005 does not fully comply with 37 CFR § 41.37(c).

37 CFR 41.37(c) states:

(c) (1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c) (1)(i) through (c) (1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c) (1)(i) through (c) (1)(iv) and (c) (1)(vii) through (c) (1)(x) of this section:

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner: Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c) (1)(ii) of this section.

A review of the application indicates that the following sections are missing from the Appeal Brief of August 15, 2005:

- 1) "Evidence appendix", as set forth in 37 CFR § 41.37(c) (1)(ix); and
- 2) "Related proceedings appendix", as set forth in 37 CFR § 41.37(c) (1)(x).

Application No. 09/668,005

Accordingly, the Appeal Brief filed on August 15, 2005 does not comply with the new rules under 37 CFR § 41.37(c). It is required that a supplemental brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board's new rules see the web page entitled More Information on the Rules of Practice Before the BPAI, Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Also, on October 25, 2005, the examiner has mailed an examiner's answer. The examiner did not include under the Evidence Relied Upon section, paragraph (8), the listing of references being applied. See MPEP § 1207.02. Before further review, the examiner must submit a corrected examiner's answer that will include the Evidence Relied Upon section with the missing reference being applied.

Accordingly, it is

ORDERED that this application be returned to the examiner to:

- 1) hold the appeal brief of August 15, 2005 defective;
- 2) request appellants to file a supplemental appeal brief in compliance with 37 CFR § 41.37 or for the examiner to submit a statement regarding the position taken on the missing appendices;
- 3) consider the substitute appeal brief;
- 4) vacate the examiner's answer mailed October 25, 2005, and issue a revised Examiner's Answer having the references being applied listed under the Evidence Relied Upon section, paragraph (8); and
- 5) for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of this appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: 

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Program and Resource Administrator  
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CF/dal

Application No. 09/668,005

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